

## REMARKS/ARGUMENTS

### STATUS OF CLAIMS

Claims 16-22, 24, 26-28 and 30-38 are now pending in this application.

### REJECTION OF CLAIMS UNDER 35 U.S.C. § 103

Claims 16-22, 24, 26-28 and 30-38 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Yoshimura et al. (USPN 5,596,419) in view of Takahashi et al. (USPN 5,805,933), and further in view of Ueki (USPN 6,310,848).

The rejections of claims 25, 26, 29 and 30-38 are respectfully traversed.

**I.** Independent claim 16 delineates, *inter alia*:

an information recording portion recording ***information on a correspondence between the still image*** recorded by said still image recording portion ***and the video*** recorded by said video recording portion;

***a digital network interface digitally bi-directionally communicating with an external apparatus;***

***a command executing portion*** interpreting a command received from the external apparatus through said digital network interface and selectively ***transmitting*** one or a plurality of the still image, the video and ***the information*** respectively recorded by said still image recording portion, said video recording portion and said information recording portion ***through said digital network interface***; and

a still image producing portion producing a still image by cutting out the still image to be recorded in the still image recording portion from the video recorded by said video recording portion, wherein

said still image producing portion cuts out a still image one of (i) at a start of the video recording, (ii) after a prescribed time from the start of the video recording and (iii) every time a prescribed period of time is elapsed.

The Examiner contends that Yoshimura et al. and Takahashi et al. disclose the claimed device except for a specific timing of cutting of video. Ueki has been relied upon to disclose a specific timing of cutting of video (column 27, lines 35+).

However, Yoshimuraa et al. fails to disclose or suggest that a command executing portion transmits information on a correspondence between a still image and a video to an external apparatus, as recited in independent claim 16 (and independent claim 26). Therefore, the recording apparatus of Yoshimura et al. cannot reproduce the video corresponding to the still image by control from the external apparatus.

Furthermore, what is disclosed at column 27, lines 35+ of Ueki is that in a playback mode of operation, a slide show command can be issued to display a still image for a certain time (e.g., 20 seconds) and then after the certain display time has passed, to switch the still picture to another one in sequence. However, this slide show command is not cutting out an image, but merely displaying images as a slide show where the images are displayed for a certain time. A person of ordinary skill in the art would not realistically look to such slide show function of Ueki in order to record information on the correspondence between the image displayed and the recorded video on the optical disc. Despite such reasonable understanding of what is disclosed in Ueki, the Examiner suggests taking this one function and then adapting it to the arrangement of Yoshimura et al. as modified by Takahashi et al., in order to meet the terms of claim 16.

Clearly, the only realistic basis for the suggested modification of Yoshimura et al. and Takahashi et al., with the teaching of displaying a still image for a certain time when a slide show command is issued, as disclosed in Ueki, is because Applicants disclose and claim the still image producing portion that cuts out a still image one of (i) at a start of the video recording, (ii)

after a prescribed time from the start of the video recording and (iii) every time a prescribed period of time is elapsed. This feature is disclosed in the present application and is different from the teaching of Ueki of displaying a still image for a certain time when a slide show command is issued. It is submitted that even after the Supreme Court decision in *KSR v. Teleflex*, 550 U.S. \_\_\_, 127 S. Ct. 1727 (2007), the Examiner still cannot properly rely upon Applicants' disclosure to support the ultimate legal conclusion of obviousness under 35 U.S.C. §103.

Thus, the rejection of independent claim 16, and dependent claims 17-22, 24 and 27, is improper as the Examiner has simply engaged in hindsight reconstruction of the claimed invention, using Applicants' structure as a template and selecting elements from references to fill in the gaps. See *In re Gorman*, 18 USPQ2d 1885 (Fed. Cir. 1991). Therefore, claims 16-22, 24 and 27 are patentable over Yoshimura et al., Takahashi et al. and Ueki.

II. Independent claim 26 delineates, *inter alia*:

an information recording portion recording ***information on a correspondence between the still image*** recorded by said still image recording portion ***and the video*** recorded by said video recording portion;

***a digital network interface digitally bi-directionally communicating with an external apparatus;***

***a command executing portion*** interpreting a command received from the external apparatus through said digital network interface and selectively ***transmitting*** one or a plurality of the still image, the video and ***the information*** respectively recorded by said still image recording portion, said video recording portion and said information recording portion ***through said digital network interface***; and

a still image producing portion producing a still image by cutting out the still image to be recorded in the still image recording portion from the video recorded by said video recording portion, wherein

said still image producing portion cuts out and records the still image by

detecting a switching of a sound multiplex mode.

Thus, the same arguments applicable to independent claim 16 are applicable to independent claim 26. Furthermore, the Examiner has not evinced wherein Yoshimura et al., Takahashi et al. or Ueki discloses a still image producing portion that cuts out and records the still image *by detecting a switching of a sound multiplex mode*. Therefore, independent claim 26 is patentable over Yoshimura et al., Takahashi et al. and Ueki.

**III.** Claim 28 requires, *inter alia*:

a digital network interface digitally bi-directionally communicating with an external apparatus;

...

an information receiving portion receiving information on a correspondence between the still image and a video through said digital network interface;

a video selection command issuing portion transmitting information capable of selecting the video through said digital network interface;

...

a still image producing portion producing the still image by cutting out the still image from the video.

The same arguments applicable to independent claim 16 are applicable to independent claim 28. The arguments include that a person of ordinary skill in the art would not realistically look to the slide show function of Ueki that works on a timer as providing specific information on a correspondence between the still image and the video from which it was cut. Therefore, claims 28 and 36 are patentable over Yoshimura et al., Takahashi et al. and Ueki.

**IV.** Claim 30 requires, *inter alia*:

an instruction issuing portion issuing an instruction for cutting out the still image through said digital network interface.

a digital network interface digitally bi-directionally communicating with an external apparatus;

...  
an information receiving portion receiving information on a correspondence between the still image and a video through said digital network interface;

a video selection command issuing portion transmitting information capable of selecting the video through said digital network interface;

...  
an instruction issuing portion issuing an instruction for cutting out the still image through said digital network interface.

Again, the same arguments applicable to independent claim 16 are applicable to independent claim 30. The arguments include that a person of ordinary skill in the art would not realistically look to the slide show function of Ueki that works on a timer as providing specific information on a correspondence between the still image and the video from which it was cut. Therefore, claims 30-35, 37 and 38 are patentable over Yoshimura et al., Takahashi et al. and Ueki.

V. In view of the above, the allowance of claims 16-22, 24, 26-28 and 30-38 is respectfully solicited.

## **CONCLUSION**

Accordingly, it is urged that the application, as now amended, is in condition for allowance, an indication of which is respectfully solicited. Should there be any outstanding

matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Edward J. Wise Reg. No. 34,523 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

By 

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